

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	:	
Simon Hunt	:	
Serial No.: 09/762,852	:	Art Unit: To be assigned
Filed: February 14, 2001	:	Examiner: To be assigned
For: INTERACTIVE SYSTEM FOR	:	Atty. Docket: 20234/0070
ENABLING TV SHOPPING	:	

DECLARATION OF HOWARD MILHENCH

Commissioner for Patents and Trademarks
Washington, D.C. 20231

Sir:

I, Howard L. MILHENCH, of 26 Caxton Street, London SW1H ORJ, England, hereby declare that:

1. I am a Chartered Patent Agent and European Patent Attorney and I am a partner in the patent law firm of R.G.C. Jenkins & Co., at the abovenoted address.
2. I am the British and European patent attorney for Media Logic Systems Ltd., owners of the entire right title and interest in U.S. Patent Application No. 09/762,852 (Hunt).
3. The above-identified patent application was prepared for filing in the United States of America by my assistant, Dr. Bobby Mukherjee, under close supervision by myself. Instructions were sent by DHL Courier on 6 February 2001 to George R. Pettit Esq. of Connolly Bove Lodge & Hutz LLP for filing of the application in the US Patent and Trademark Office (USPTO), such instructions being under signature of Dr. Mukherjee. Dr. Mukherjee is no longer an employee of my firm.

4. At the time of forwarding of the application for filing in the USPTO, the inventor, Mr. Simon Hunt, had been requested to execute the required formal documents for the US application but had not yet done so. The instructions provided to Mr. Pettit provided this information to him. A copy of the letter dated 5 February 2001 sent to Mr. Hunt and asking for his signature on the Declaration and Power of Attorney for the present application is appended hereto as **Exhibit A**.
5. Mr. Hunt replied to my letter on 9 February 2001 and a copy of his letter is appended hereto as **Exhibit B**. Note that he said in the 4th paragraph of his letter:

"... I see no problems in verifying and executing the required paperwork, as there is no doubt over the inventor and no dispute over ownership of any Intellectual Property created during my employment with Nisaba Group."

At the time when Mr. Hunt conceived the invention in question he was a Director of Nisaba Group. I understood his letter of 9 February 2001 to say that he accepted that the invention belonged to Nisaba and that he would sign the formal papers as requested.
6. I sent reminder letters to Mr. Hunt on 3 May 2001 and on 16 May 2001 and copies are appended hereto as **Exhibits C** and **D** respectively. In the meantime I learned that Mr. Hunt had executed an assignment document on 1 May 2001 and I sent a copy to Mr. Pettit on 17 May 2001. This assignment document gave power of attorney on behalf of Mr. Hunt to Media Logic Systems Ltd. A copy of the assignment is appended hereto as **Exhibit E**.
7. On 19 June 2001 I wrote again to Mr. Pettit. A copy of this letter is appended hereto as **Exhibit F**. I had been in telephone contact with Mr. Hunt regarding the missing papers for the US patent application and he had made the point to me that there was no need for him to sign anything since he had given power of attorney to Media Logic Systems Ltd. in the assignment document dated 1 May 2001. I asked Mr. Pettit if a Director of Media Logic Systems Ltd. could sign the papers on behalf of Mr. Hunt. At the same time I wrote to Mr. Anthony Lee, attorney for Mr. Hunt, at his firm, Messrs. Kingsford Stacey Blackwell, at the suggestion of Mr. Hunt, to elicit his assistance; a copy of my letter to Mr. Lee is appended hereto as **Exhibit G**. Mr. Lee replied on 20 June 2001

asking that we would undertake to pay his firm's reasonable charges and on 21 June 2001 I emailed Mr. Lee to confirm acceptance of this; a copy of this email is appended hereto as **Exhibit H**. I sent a reminder to Mr. Lee on 27 June 2001.

8. I wrote again to Mr. Pettit on 27 June 2001 to appraise him of the situation and a copy of that letter is appended hereto as **Exhibit I**.
9. On 4 July 2001 I received an email from Mr. Lee saying that he had asked Mr. Hunt to sign the forms and provide them to him as soon as possible. On 6 July 2001 I received a letter from Mr. Lee in which he sought payment of £3000 to Mr. Hunt; a copy of this letter is appended hereto as **Exhibit J**. On 9 July 2001 I received an email from Mr. Lee asking for £3750 for Mr. Hunt and £625 for his own services; a copy of this email is appended hereto as **Exhibit K**. I replied to Mr. Lee in an email on 10 July 2001 and whilst agreeing to meet his firm's charges, I said that Mr Hunt's proposed charge was staggering and I offered £1500; a copy of this email is appended hereto as **Exhibit L**. The offer of £1500 had previously been agreed with our clients. I also wrote to Mr. Pettit on 10 July 2001 advising him of the situation with Mr. Hunt and enclosing formal papers signed by Mr. Brown, Managing Director of Media Logic Systems Ltd. under the power of attorney given by Mr. Hunt in the assignment document dated 1 May 2001; a copy of this letter to Mr. Pettit is appended hereto as **Exhibit M**.
10. On 13 July 2001, I emailed Mr. Lee to confirm that our offer of £1500 to Mr. Hunt was final. An email in reply was received on 17 July 2001 which advised that Mr. Hunt had increased his charge to £3625. Copies of these emails are appended hereto as **Exhibits N and O** respectively. On 24 July 2001, Mr. Lee emailed me to ask about the matter of Mr. Hunt's charges and I replied on 7 August 2001. A copy of my emailed reply is appended hereto as **Exhibit P**. There was no further correspondence between us. We paid Mr. Lee's firm, but Mr. Hunt did not accept our offer, and the formal papers signed by him were not released to us and, to this day, have not been released to us.

11. It is to be well understood that the offer of £1500 to Mr. Hunt was made solely in the interests of seeking to resolve the situation and does not indicate acceptance that Mr. Hunt was entitled to payment. Indeed he was not. He made the invention whilst in the employment of Nisaba Group and the invention was properly the property of the company and was not Mr. Hunt's property. That this is the case is enshrined in Section 39 of the 1977 British Patents Act. Furthermore Mr. Hunt had already executed the assignment dated 1 May 2001. Mr. Hunt had received good and valuable consideration for his invention and his demand for further payment was legally and morally indefensible. There was no justification to pay for property previously acquired from Mr. Hunt.
12. As the undersigned attorney for the owner of the invention and of the abovementioned US patent application, I maintain that I have made every effort, to secure the inventor's cooperation in the filing of this application. His refusal to deliver the signed documents to me continues to this day despite the efforts that I made to secure his cooperation.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Howard L. Milhench

Howard L. Milhench

21 AUGUST 2002

Date

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